

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

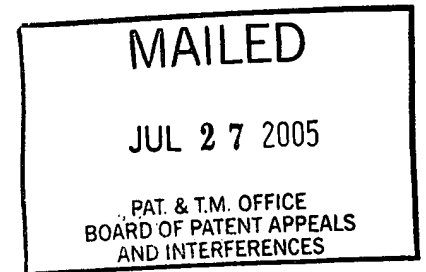
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MANFRED ELZENBECK

Appeal No. 2005-1048
Application No. 09/622,830

HEARD: June 7, 2005



Before PATE, NASE, and CRAWFORD, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 15 to 28, 42, and 43, which are all of the claims pending in this application. Claims 1 to 14 and 34 to 41 have been cancelled and claims 29 to 33 have been withdrawn from consideration.

BACKGROUND

The appellant's invention relates to a lounge chair with a frame and spring element held by the frame (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The Prior Art References

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Baker	2,127,710	Aug. 23, 1938
Bartz	3,636,573	Jan. 25, 1972
Abu-Isa et al. (Abu-Isa)	4,869,554	Sep. 26, 1989
Eng (GB 2038382)	2 038 382	Jul. 23, 1980

The Rejections

Claims 15 to 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Baker in view of GB 2038382.

Claims 19 to 22 and 42 to 43 stand rejected under 35 U.S.C. § 103 as being unpatentable over Baker in view of GB 2038382 and further in view of Abu-Isa.

Claims 23 to 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Baker in view of GB 2038382 and further in view of Bartz.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer

(mailed November 17, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed October 6, 2003) and reply brief (filed December 17, 2004) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's rejection of claims 15 to 18 under 35 U.S.C. § 103 as being unpatentable over Baker in view of GB 2038382. The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

The examiner relies on Baker for teaching substantially the invention as recited in claim 15 except that the examiner realizes that Baker does not disclose an elastic textile. The examiner relies on GB 2038382 for this teaching and concludes:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an elastic textile product with rubber threads and polyester as taught by GB 2038382 in lieu of the rubber

material of Baker in order to provide an improved resilient stretchable fabric to be tensioned between the bars [answer at page 4].

We will not sustain the examiner's rejection. Firstly, we agree with the appellant that an obvious determination is not supported by the combination of Baker and GB 2038283 because there is no motivation to combine the teachings of Baker and GB 2038382. We note that when it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellant. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the appellant's invention. As in all determinations under 35 U.S.C. § 103, the decision maker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellant's combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the

combination. See In re Beattie, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

In the present case, the examiner has not directed our attention to motivation in the cited references that would have suggested to a person of ordinary skill in the art to make the combination. Baker relates to a furniture comprised of rubber material. GB 2038382 relates to an elastic textile product. Although it may be possible to replace the rubber material of Baker with the elastic fabric of GB 2038382, the examiner has not established why one of ordinary skill in the art would have been motivated to do so. Therefore, the examiner's rejection falls on this basis alone.

In addition, we agree with the appellant that Baker does not disclose a first prestress in a first section which is substantially different from a second prestress in a second section. There is no disclosure in Baker that the rubber material is prestressed as required by the limitation of claim 15. While the examiner may be correct that the rubber material is stressed prior to placing on the furniture frames such is not necessarily the case. It is possible that the rubber material is not prestressed before placement on the furniture frame. In addition, there is certainly no factual support for the examiner's finding that any prestress which may exist in one section is substantially different from the prestress in another section.

In view of the foregoing, we will not sustain the examiner's rejection of claim 15 or claims 16 to 18 dependent therefrom.

We will also not sustain the rejection of claims 19 to 22 and 42 to 43 under 35 U.S.C. § 103 as being unpatentable over Baker in view of GB 2038382 and further in view of Abu-Isa. Firstly, this rejection is based on the combination of Baker and GB 2038382. In addition, as these claims are dependent on claim 15, the claims include the limitation regarding the prestress of the elastic element. We have examined the disclosure of Abu-Isa and it does not cure the deficiencies noted above in regard to Baker and GB 2038382 with respect to the prestress of the elastic member.

In addition, we will not sustain the rejection of claims 23 to 28 under 35 U.S.C. § 103 as being unpatentable over Baker in view of GB 2038382 and further in view of Bartz. Firstly, this rejection is based on the combination of Baker and GB 2038382. In addition, as these claims are dependent on claim 15, the claims include the limitation regarding the prestress of the elastic element. We have examined the disclosure of Bartz and it does not cure the deficiencies noted above in regard to Baker and GB 2038382 with respect to the prestress of the elastic member.

The examiner's rejection is reversed.

To summarize, the decision of the examiner to reject claims 15 to 33, 42, and 43 under 35 U.S.C. § 103 is reversed.

Wm. Farr


JEFFREY V. NASE

MURRIEL E. CRAWFORD
Administrative Patent Judge

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